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| APPLICATION NUMBER | 08/800,742 | FILING DATE | 02/14/97 | FIRST NAMED APPLICANT | FIELD | ATTY. DOCKET NO. | P 1231-272A |
| | | | | | | EXAMINER | |

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PM41/0730

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| EXHIBIT | PAPER NUMBER |
| ART UNIT | |

3627

DATE MAILED:

07/30/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on July 7, 1998

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-20, 22-26 is/are pending in the application.
Of the above, claim(s) 20 is/are withdrawn from consideration.
- ☒ Claim(s) 1-12 is/are allowed.
- ☒ Claim(s) 13, 17-19, 22, 26 is/are rejected.
- ☒ Claim(s) 14-16, 23-25 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☒ The drawing(s) filed on 1-22-98 ~~is/are objected to by the Examiner.~~ have not been examined for approval.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s): _____
- ☒ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

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DETAILED ACTION

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 13, 17-19, 22, and 26 are rejected under 35 U.S.C. 103(a) as being as being unpatentable over Aston 5,351,042 and Gokcebay et al. 5,552,777. See particularly Aston, figure 4 and column 3, line 50 to column 4, line 3. It would have been an obvious relocation and reversal of parts to mount the nitinol wire and lever 42 in the plug which is accepted into a recess of the casing in a manner similar to that set forth in Gokcebay et al. for the reasons set forth therein.

Allowable Subject Matter

4. Claims 1-12 are allowed.
5. Claims 14-16, 23-25 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

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Response to Arguments

6. Applicant's arguments filed July 7, 1998 with regards to claims 1-12, 14-16, 23-25 have been fully considered and are deemed persuasive. With regard to the species claimed in claim 20, no generic claim has been deemed allowable and therefore claim 20 is still withdrawn from consideration by the Examiner. The Examiner can not agree with Applicant's argument that there is no motivation to combine the teachings found in Aston and Gokcebay et al. to make obvious applicant's invention of claims 13, 17-19, 22 and 26. Aston teaches all the elements of these claims with the exception of the nitinol actuator being mounted in the plug. Aston further teaches that the nitinol actuator can replace (i.e. functionally equivalent to) a solenoid actuator. See column 3, lines 50-52. Gokcebay et al. teaches the benefits of housing the electronic access feature of a cylinder lock in the mechanical lock plug itself. Gokcebay et al. further teaches that it is well within the skill level of the person of ordinary skill to mount a solenoid actuator within the plug of the cylinder. The Examiner maintains that the person of ordinary skill in the art would be motivated by the teachings of Aston and Gokcebay et al. to arrive at applicant's claimed invention for the reasons set forth in these references. The Examiner maintains that the person of ordinary skill would know how to make the mechanism of Aston small enough that it could be incorporated into the plug of the key lock in the same manner as that set forth by Gokcebay et al. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined

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teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

7. The Examiner has attempted to clearly and concisely address all of applicant's arguments in regard to the claims that are still rejected. Any argument which is not specific to these current claims is moot.

Conclusion

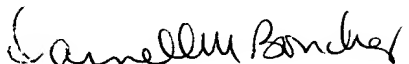
8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darnell Boucher whose telephone number is (703) 308-2492.

dmb

July 29, 1998


Darnell M. Boucher
Primary Examiner